

## **II. REMARKS/ARGUMENTS**

The application still contains 48 claims.

Claims 1 and 46 have been amended. Support for the amendment made to claims 1 and 46 can be found, *inter alia*, on page 6, lines 23-25 of the specification as originally filed.

Claim 24, formerly independent, has been rendered dependent on claim 46.

Claims 25-29 and 32-45 have been amended in order to change the claim dependencies.

It is respectfully submitted that no new matter has been added to the application under the present amendment.

### **A. Summary of Rejections and Reply**

#### **1) Rejection of claims 1-48 under 35 USC 102**

On page 2 of the Office Action, the Examiner has rejected claims 1-48 under 35 USC 102(b) as being anticipated by Ginter et al. U.S. Patent No. 5,892,900 (hereinafter referred to as "Ginter"). For the reasons presented below, the Applicants respectfully submit that claims 1-48 are in condition for allowance.

#### **Independent claim 1**

The Examiner's attention is directed to the following elements of amended claim 1, portions of which have been emphasized:

- "1. A method of facilitating a **technical due diligence process** involving a target entity having software assets, comprising:

using a software analysis tool to extract information on the target entity's software assets; and  
**performing at least one subsequent step in the technical due diligence process** as a function of the extracted information."

It is respectfully submitted that Ginter does not anticipate the elements of claim 1.

To begin with, it is respectfully submitted that Ginter is totally unconcerned with, and makes no mention or remote suggestion of, a technical due diligence process. Rather, Ginter solely describes a system for "secure transaction management" and "electronic rights protection in electronic commerce and other electronic or electronically-facilitated transactions" (emphasis added, see, *inter alia*, abstract section; col. 1, lines 9-20; col. 2, lines 20-32; and col. 21, lines 41-46).

Now, the Examiner will appreciate that a due diligence process is typically a part of a corporate transaction such as a merger, acquisition, investment and the like (as mentioned, for instance, on page 1, line 14 to page 2, line 7 of the specification as originally filed). Clearly, these types of corporate transactions and any associated due diligence processes have nothing to do with electronic commerce transactions. It is thus not surprising that Ginter is totally devoid of any mention or suggestion of a due diligence process, let alone a technical due diligence process.

Incidentally, it is noted that, on page 2 of the Office Action, the Examiner rejected original claim 24 which was, prior to the present amendment, an independent claim directed to a "method of performing technical due diligence". In rejecting the original claim 24, the Examiner did not even attempt to address the technical due diligence aspect of the claim<sup>1</sup>. This substantially weakens the Examiner's rejection, to the point where it is not clear how claim 24 (and now

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<sup>1</sup> It is actually not surprising that the Examiner was unable to refer to any portion of Ginter in this rejection, since Ginter completely and utterly fails to mention the issue of **technical due diligence**.

claim 1, which recites the "technical due diligence" feature) could remain rejected.

In addition, since Ginter in no way teaches or suggests a technical due diligence process, Ginter also cannot possibly be held to teach or suggest the second element of claim 1, namely "performing at least one subsequent step in the technical due diligence process as a function of the extracted information".

For the above reasons, it is respectfully submitted that claim 1 is in no way anticipated by Ginter. Accordingly, the Applicants respectfully submit that claim 1 is in condition for allowance. The Examiner is thus respectfully requested to withdraw his rejection of claim 1.

#### Dependent claims 2 to 23

Claims 2 to 23 depend either directly or indirectly on claim 1 and therefore include all of the elements of claim 1. Hence, for the same reasons as those set forth herein above in respect of claim 1, the Applicants respectfully submit that claims 2 to 23 are in condition for allowance. The Examiner is thus respectfully requested to withdraw his rejection of claims 2 to 23.

#### Independent claim 46

The Examiner's attention is directed to the following elements of amended claim 46, portions of which have been emphasized:

"46. A method of facilitating a **technical due diligence process** involving an expanding entity and a target entity having software assets, comprising:

a third party using a software analysis tool to extract information on the target entity's software assets;

the third party providing the extracted information to the expanding entity; and

**the expanding entity performing at least one subsequent step in the technical due diligence process** as a function of the information provided by the third party."

It is respectfully submitted that Ginter does not anticipate the elements of claim 46.

Specifically, the above-emphasized elements are similar to the elements discussed above in connection with claim 1. Accordingly, for the same reasons as those set forth above in respect of claim 1, it is respectfully submitted that Ginter:

- (1) is totally unconcerned with, and makes no mention or remote suggestion of, a technical due diligence process; and, therefore,
- (2) neither teaches nor suggests the last element of claim 46, namely "the expanding entity performing at least one subsequent step in the technical due diligence process as a function of the information provided by the third party".

For the above reasons, it is respectfully submitted that claim 46 is in no way anticipated by Ginter. Accordingly, the Applicants respectfully submit that claim 46 is in condition for allowance. The Examiner is thus respectfully requested to withdraw his rejection of claim 46.

Dependent claims 24 to 45, and 47 and 48

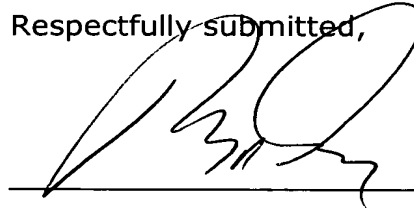
Claims 24 to 45, and 47 and 48 depend either directly or indirectly on claim 46 and therefore include all of the elements of claim 46. Hence, for the same reasons as those set forth herein above in respect of claim 46, the Applicants respectfully submit that claims 24 to 45, and 47 and 48 are in condition for allowance. The Examiner is thus respectfully requested to withdraw his rejection of claims 24 to 45, and 47 and 48.

### **III. CONCLUSION**

In view of the foregoing, the Applicants are of the view that claims 1-48 are in condition for allowance. Favorable reconsideration is requested. Early allowance of the application is earnestly solicited.

If the claims of the application are not considered to be in full condition for allowance, for any reason, the Applicants respectfully requests the constructive assistance and suggestions of the Examiner in drafting one or more acceptable claims pursuant to MPEP 707.07(j) or in making constructive suggestions pursuant to MPEP 706.03 so that the application can be placed in allowable condition as soon as possible and without the need for further proceedings.

Respectfully submitted,



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